

REMARKS

The Examiner presumption relative to the common ownership of the invention, as stated in paragraph 1 of the Office Action, is correct.

Two key features characterize the presently claimed process for the continuous preparation of thermoplastic polyurethane elastomers. The first concerns the period of time during which the reactants are premixed and requires that such mixing be carried out during, at most, 5 seconds. The second is the temperature difference between the indicated reactants: Before entering the reactor, the reactants are at respective temperatures that differ one from the others by less than 20°C (herein "Temperature Difference").

The claims stand rejected under 35 U.S.C. 102(b) said to be anticipated by Kirchmeyer et al (U.S. Patent 5,739,252) or Ulrich et al (U.S. Patent 3,963,679).

The standard for anticipation under section 102 of the statute is one of strict identity: to anticipate a claim, the reference must contain all essential elements of the claimed invention.

The Examiner admits that neither reference disclosed anything relative to Temperature Difference yet asserts that "the initial processing temperatures were within the temperature difference range for the components of the claims". The examiner is understood to infer the "Temperature Difference" from the "initial processing temperatures", that are 50 to 250°C per Kirchmeyer and 90 to 280°C in accordance with Ullrich.

This inference is untenable. Clearly, there is a large number of possible combinations of temperatures of the relevant reactants that would yield the referenced "initial processing temperature". Most of these combinations would not describe the temperatures of the reactants as required by the present claims.

The Examiner further contends that the logical basis for this inference is “because introduction of reactants into processing equipment at comparable temperatures was accepted and conventional processing technique” at the critical time. Unless accompanied by factual support, this naked assertion has no legal effect and is believed to merit no reply. Moreover, Ullrich, in Example 4 disclosed a difference of 40°C between the temperatures of the relevant reactants.

Lastly the Examiner asserts that “holding and storing reactants at room temperature prior to processing is a universal, economically desirable practice” (emphasis added). Countering this unsupported statement is the clear disclosure in the cited Rausch reference (U.S. patent 3,642,964) that in column 5 line 58 et seq. disclosed preheating, to maintain the various reactants in the molten state. Ullrich, in Examples 6 and 9, disclosed storing at 80°C.

Reconsideration of the rejections under section 102(b) and their withdrawal are respectfully requested.

The claims stand rejected under 35 U.S.C. 103(a) said to be unpatentable over Kirchmeyer et al (U.S. Patent 5,739,252) or Ullrich et al (U.S. Patent 3,963,679) each in view of Rausch et al (U.S. Patent 3,642,964).

In maintaining this rejection the Examiner relies on the arguments made in the context of the anticipation rejection. Applicants believe their rebuttal arguments are applicable here as well: there is nothing in the record to show that “common processing techniques” included the feeding of reactants at temperatures displaying Temperature Difference. Moreover, nothing in the statute requires applicants to establish that the prior art is outside the scope of their claims; it is the Patent Office burden to show that it is inside the scope.

Believing the above to completely respond to the outstanding Office Action and their application be in condition for allowance, Applicants respectfully solicit an early indication of allowance.

Respectfully submitted,

By



Aron Preis
Attorney for Applicants
Reg. No. 29,426

Bayer Corporation
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-8343
FACSIMILE PHONE NUMBER:
(412) 777-8363

s:/sr/ap0181